

REMARKS

In light of the above amendatory matter and remarks to follow, reconsideration and allowance of this application are respectfully solicited.

In the Office Action under reply, all of the claims grouped in Group II in the Office Action dated February 24, 2010, namely, claims 125-132, 138, 140-141, 146-148, 152, 156-157, 163, 167, 168, 239-244, 375-380, 383-385, 388 and 390-391 were examined on their merits.

Claims 125, 225 and 388 were rejected, in the Office Action under reply, as being anticipated by Hamrick (U.S. Pat. 4,596,381).

By this amendment, claims 225 and 388 are canceled; and claim 125 is amended to depend from claim 131. Claim 131 was rejected as being obvious in view of the combination of Hamrick in view of PCT publication WO 00/44275 (Voloshin). It is assumed, therefore, that claim 125, as presented herein, likewise is rejected in view of the combination of Hamrick and Voloshin. Accordingly, for the purpose of the present discussion, Applicants' representative treats claims 125-132, 138, 140-141, 146-148, 152, 156-157, 163, 167, 168, 375, 377-380, 383-384 and 390 as being rejected over this combination. All remaining claims have been either canceled or withdrawn from further consideration following the restriction requirement of February 24, 2010.

By this amendment, independent claim 131 is amended. Claim 125 is amended to depend from claim 131 and new dependent claims 393-397 are presented. Accordingly, claims 125-132, 138, 140-141, 146-148, 152, 156-157, 163, 167, 168, 375, 377-380, 383-384, 390 and 393-397 are presented for further consideration.

It is respectfully submitted, claim 131, the only independent claim that is not withdrawn and that is presented for further consideration, is patentably distinct over the combination of Hamrick and Voloshin for the reasons now discussed.

Claim 131 is directed to apparatus for use in a body lumen. Such apparatus must be of careful construction so as not to damage or otherwise injure delicate body tissue. Hamrick, however, is concerned with a completely different technical field, namely, use of a pull line to install electric wires in electrical conduit between junction boxes (see Hamrick, Abstract). Hamrick installs such electric wires by “blowing” a “projectile” through a conduit (col. 4, lines 43-49). This projectile is an inflatable bag-like member of “highly flexible, imperforate and air tight, **non-elastic plastic or plastic-coated fabric**” (col. 2, lines 45-47, emphasis added) that is attached to pull line 12 that passes freely through conduit C. A seal-off 14 is used to plug one end of conduit C and is connected to tube 16 to supply fluid under pressure to the inflatable bag to move the bag through the conduit. It is readily apparent, such non-elastic plastic or plastic-coated fabric cannot possibly be used “in a body lumen.” To do so would cause untold and possibly irreparable damage to body tissue. Thus, one of ordinary skill in the art who is concerned with imaging body lumens, such as an endoscope, would not even remotely consult the electric wire installation art, of which Hamrick is representative.

It appears the Examiner is of the view that Hamrick’s conduit C can be construed to be a body lumen and that a medical tool used in a medical procedure can be interpreted as a mechanical device for installing electrical wires. It is respectfully submitted, this interpretation is unwarranted. As detailed in the specification of the present application, the present invention is directed to a system for use in a body lumen to enable a medical device to navigate through a body lumen, the body lumen having a varying diameter throughout its length as well as including

several corners that must be navigated. Thus, as a result of the present invention, a medical device can be maneuvered in the body lumen with a minimal amount of trauma to the walls of the body lumen.

The body lumen of Applicants' claim 131 cannot be interpreted as a "conduit" of the type described by Hamrick. First of all, Hamrick's conduit C is a rigid element having the same fixed-value diameter along all its length. The configuration of Hamrick's device for installing the electrical wires is based on this feature of the conduit C. On the contrary, a body lumen in general and a colon of a patient in particular has a variable diameter. The body lumen through which the system of the present invention passes is not analogous to the conduit C of Hamrick. Conduit C exhibits a generally fixed diameter throughout its entire length, in contradistinction to the varying diameter of the body lumen described in the present invention.

Voloshin was cited for its alleged description of an image-capturing device mounted on a carrier (see page 4 of the Office Action under reply). The Examiner asserts that Voloshin teaches "an inflatable auxiliary piston head ... mounted on said carrier..." (page 5 of the Office Action). However, claim 131 recites:

said image-capturing device being configured to provide omnidirectional lateral viewing; and an inflation element, fixed in a second vicinity of the distal end, and adapted to increase a diameter of the carrier in the second vicinity to an extent sufficient to position the image-capturing device a distance from a wall sufficient to enable omnidirectional focusing of the image-capturing device.

Voloshin, at best, describes bellows 25, 27 that are used to tilt head 22 "to capture an image ... on an area of interest that is not directly in front of the probe" (page 7, lines 1-8 of Voloshin). Thus, Voloshin's optical pickup 28 can only pick up images that are directly in front of lens 30; and to pick up images that are not in front of the lens, the bellows are used to tilt the

head and, thus, the lens, to do so. This demonstrates that Voloshin's pick up 28 is not omnidirectional. If it were, there would be no need for bellows 25,27.

In view of the clear description found in Voloshin, it is seen that Voloshin does not describe an "omnidirectional image-capturing device." Nor does Voloshin describe "an inflation element... adapted to increase the diameter of the carrier ... sufficient to position the image-capturing device a distance from a wall sufficient to enable omnidirectional focusing" as recited by Applicants' claim 131. Therefore, Voloshin does not suggest features recited by claim 131 and, in view of the dependency of the remaining claims in this application, Voloshin fails to enable one of ordinary skill in the art to make and use Applicants' claimed invention.

Moreover, it is respectfully submitted, Hamrick and Voloshin cannot be combined in the manner suggested by the Examiner. That Hamrick and Voloshin are from unrelated arts is self evident. There is no reason to combine these references, and none has been suggested – especially since, as noted above, if Hamrick is used in a body lumen (which is the intended use of Voloshin), the result very likely would be disastrous to the patient.

Therefore the withdrawal of the rejection of the claims as being obvious in view of the combination of Hamrick and Voloshin is respectfully requested.

All the claims remaining in this application (with the exception of new claims 393-397) were rejected on the ground of obviousness-type double patenting in view of Applicants' issued U.S. Pat.7,635,346. To overcome the double patenting rejection, Applicants submit herewith a Terminal Disclaimer together with the disclaimer fee.

Statements appearing above in respect to the disclosures in the cited references represent the present opinions of the undersigned attorney and, in the event the Examiner disagrees with

any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the references providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment to our Deposit Account No. 50-0320.

Respectfully submitted,

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